



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,934	01/22/2001	Carl A. Wright	SLC-10102/29	1234

25006 7590 10/19/2006

GIFFORD, KRASS, GROH, SPRINKLE & CITKOWSKI, P.C
PO BOX 7021
TROY, MI 48007-7021

EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/766,934	WRIGHT, CARL A.	
	Examiner	Art Unit	
	Yogesh C. Garg	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-32 is/are pending in the application.
- 4a) Of the above claim(s) 30 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-29 & 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 7/26/2006 has been entered.

Further, in line with the Interview summary mailed on 8/15/2006, Abandonment mailed On 8/1/2006 is withdrawn because the applicant has filed RCE and the submission within permissible time by 7/26/2006.

Response to Amendment

2. The applicant's amendment received on 7/26/2006 is acknowledged and entered. The applicant has canceled all the previously presented claims 1-23 and added new claims 24-32. Currently claims 24-32 are pending for examination.

Claim Objections

3. Claim 4 is objected to because of the following informalities: It recites in line 1, " The method of claim 1" which is incorrect and should be replaced by—The method of claim 24---. Appropriate correction is required.

Election/Restrictions

4. Newly submitted claims 30-31 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 30 and 31 are directed to non-elected species B and C, Office action for Restriction requirement mailed on 2/26/2004 and the Applicant's Response to Restriction filed on 3/25/2004.

Since applicant has received an action on the merits for the originally presented Species A, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 30-31 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Therefore, claims 24-29 and 32 will be further treated on merits.

Claim Rejections - 35 USC § 112

5 The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 32 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim 12 contains subject matter, "selecting a language in which to produce the bill and converting all correlated data to the selected language prior to generating the bill", which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 24-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Ensel et al. 9US Patent 6,493,685 B1), hereinafter, referred to as Ensel.

Regarding claim 24, Ensel discloses a method of providing customized billing services, comprising the steps of:

providing a plurality of software objects, at least certain of which are capable of accessing an outside source, accessing one or more other software objects, or creating one or more new software objects, each object being operative to acquire and process data specific to a bill or the recipient thereof; configuring a subset of the software objects to generate customized bill content for a particular bill recipient; repetitively invoking the software objects of the subset, and any software objects that they access or create, until all of the objects have completed the data acquisition and processing actions required to generate the customized bill content; and producing a bill by formatting the customized bill content for the particular bill recipient See at least the following segments:

col.6, lines 43-50, *"As described in more detail below, it is the responsibility of the IIP 20 to reformat the billing data 55 in the format required for its own internal databases and then to format the actual published bill, statement or other information as is appropriate for the channel*

Art Unit: 3625

of distribution particular to a specific customer 80 receiving the presented bill or other information.

col.4, lines 17-39, " In order to carry out the task of presenting the bills to the consumer, the IIP must have access to the "raw" billing data from the biller. ***This access can be accomplished either through direct access by the IIP to the accounting systems of the biller or through a data feed from the biller to the IIP.*** Once the billing data has been received by the IIP, the IIP formats the billing data for storage in its own internal database and then performs the task of formatting the bill for the particular channel(s) of distribution selected by the customer. ***Each biller has its own format and content for its "raw" billing data. Each channel of distribution has a distinct format and restrictions on content. Each customer has its own selected preference(s) for the channel on which the bill is to be presented. In light of all of these variables, the function of correctly formatting a particular bill for a particular customer is a significant task for the IIP. The present invention performs this formatting task using relational and object oriented databases which are the core of the BAP*** ", and also Figs.2, 5, and

col.10, line 3-col.14, line 5 "FIG. 2 illustrates an overview of structure of the elements of the present invention as well as the processing and data flow. Element 200 illustrates the structure of the Biller Acquisition Platform (BAP). The central feature of the design of the BAP 200 is that it is a database driven system. ***The BAP 200 includes a database server 202 having, for example, six database including an Enrollment file 205; a Bill Summary file 210; an E-Bill file 215 containing both current and historical data related to E-Bills; a Template file 200 containing the templates required to format electronic bills for the various channels of distribution 310-320; a preferred presentment vehicle (channel of distribution) and alternate presentment vehicles; customer presentment preferences (e.g., present my bill as soon as available, at the end of month, exception presentment (only present my bill if dollar amount exceeds a limit, otherwise automatically pay the bill, generate a paper bill if condition X occurs . . .)); presentment configuration data (e.g., Email address, Email system/protocol, browser type and version . . .);***

bill format preferences (e.g., send me summary only, partial details, full details . . .); reminder preferences The structure and content of the Summary file 210 and the E-Bill file 215 varies from biller to biller. The Summary file includes the highest level representation of the customer's bill. Examples of the type of data included in the Summary file 210 are the customer's name, account number, location (address) of the bill destination, account balance, current amount due, amount past due, and minimum due. The E-Bill file 215 contains data related to the customer's current E-Bills along with historical E-Bill data which is retained for a certain period of time. The E-Bill data residing in this file 215 contains the detailed description of the customer's bill (e.g., details of all of the charges on a credit card for the applicable period in the case of a credit card biller). In a preferred embodiment of the present invention, the E-Bill file 215 is an object oriented file in which the E-Bills are stored as objects. The E-bill file 215 can be both industry specific and/or biller specific. For example, if the IIP 20 has several utility billers, a standard format for a utility bill can be derived (e.g., a graph illustrating the customer's usage). Within the standard format, each utility biller can customize the format of its own bill to be presented to its customers 80. Alternatively, each biller can custom format the entire look and feel of its bill.....",

col.12, lines 12-18 and lines 31-42, " if the biller 5 desires to maintain electronic data for all of its customers 80, in anticipation of the customers 80 eventually signing up for electronic bill presentment. In such a case, the IIP 20 is able to immediately present an electronic bill to the previous paper customer 80. Element 245 is a reformatting processor which reformats the legacy billing data from the biller 5 in the appropriate format for inclusion on the database server 202. The billing data for the electronic bills is passed from the splitter 255 to the reformatting processor 245 ... The details of the formatting by reformatting processor 245 varies from biller to biller and is driven by the format of the billing data provided by the biller. The reformatting processor 245 feeds the Summary data file 210 and the E-Bill database 215 with the data as described above with respect to each of these databases 210, 215. ", and

Col.13, lines 27-62, "With respect to the Summary 210 and E-Bill 215 data files, BAP system

Art Unit: 3625

*200 is capable of performing the following functions: storing a predetermined amount (e.g., thirteen months) of bill data history for each biller 5; accepting manual entry/update of bill data and producing an audit trail; receiving, editing and uploading legacy billing data files from biller 5; sending and receiving summary data; producing audit trails of all addition, change, and delete activity on files 210 and 215; extracting, reformatting, and transmitting billing data files; performing custom analysis of bill data and producing reports; and providing expandability for anticipated growth of bill and non-bill data (e.g., marketing inserts 60). With respect to the marketing inserts 60 contained in file 235, the BAP 200 can: receive and store a predetermined amount (e.g., thirteen months) of insert history; receive, store and execute the logic required for developing and executing the conditional targeting associated with the marketing inserts 60; track a wide variety of access statistics (e.g., number read by customers 80, number responded to, types of customers 80 who responded . . .); online processing of responses from customers 80 (e.g., "I want to buy that luggage, please debit my account and send it to . . . "); and certification that an insert was read (for regulatory purposes among others). ... Armed with all of the above, the BAP 200 is capable of creating an electronic bill. How the electronic bill is formulated (in an email, as an HTML page . . .) and where it is delivered (to an email address, to a presentment site . . .) will be governed by the customers' 80 enrollment data contained in database 205. **Application `plug-ins` residing on application server 240 accomplish the actual formatting of the electronic bills. The plug-ins contain the software required to format the data in E-Bill 215 and Summary 210 files for the channel of distribution to which an electronic bill is to be published. There is a different plug-in for each channel of distribution."***

Note: The above segments disclose that the sets of data used for bill contents are stored as a plurality of software objects, that is a subset of objects, in an object oriented E-bill file 215. This indicates that the subset of objects required for to provide bill contents for a particular bill recipient are instantiated, i.e. created or generated whenever invoked and in order to generate a plurality of data, such as *presentment configuration data (e.g., Email address,*

Art Unit: 3625

Email system/protocol, browser type and version . . .); bill format preferences (e.g., send me summary only, partial details, full details . . .); reminder preferences The structure and content of the Summary file 210 and the E-Bill file 215 varies from biller to biller", will require repetitive invoking of the plurality of software objects. The object-oriented E-Bill file 215 receives the data from several databases/servers and billers.

Regarding claim 25, Ensel discloses that the method of claim 1, wherein a portion of the collected data is correlated to more than one of the specific fields in the bill format (see at least col.10, line 21-col.11, line 5, which describes an E-bill file 215 varying from biller to biller and includes fields such as, customer's name, account number, address, etc. and this information is collected by the IIP to present the bills to the customers. The information collected on customer's name, address, account number, biller's information, account balance, etc. is the collected data which is correlated to more than specific fields in the bill format. See also col.10, line 21-col.14, line 53).

Regarding claims 26-27, Ensel, does show that the collected data further comprises detailed information pertinent to a billing account of the client and segmenting the detailed information into different portions of the bill (see at least col.10, line 21-col.14, line 53. The details of the charges on a credit card plus marketing inserts correspond to the claimed detailed information pertinent to a billing account which is segmented into different portions of the bills as details about charges and marketing/advertising information).

Regarding claim 28, Ensel discloses that the method of claim 24, further comprising the steps of generating separate images from the collected data and correlating the separate images to at least two specific fields (see at least col.10, line 21-col.14, line 53 which discloses generating bills for different bills to customers. For different billers for the same customer two

Art Unit: 3625

different bills/ bill images would be generated from the collected data and the two different bills would correlate to at least two specific fields such as biller's name, customer's account number, customer's name, account balance, etc.).

Regarding claim 29, Ensel discloses that the method of claim 28, wherein the separate images further comprises summary information and detailed information. (see at least col.10, lines 50, "*The structure and content of the **Summary file 210** and the **E-Bill file 215** varies from biller to biller. The Summary file includes the highest level representation of the customer's bill. Examples of the type of data included in the Summary file 210 are the customer's name, account number, location..... The E-Bill data residing in this file 215 contains the **detailed description** of the customer's bill (e.g., details of all of the charges on a credit card for the applicable period in the case of a credit card biller).*". The information in summary file 210 and file 215 corresponds to the claimed summary information and detailed information which are included in the bill to be presented to the customer, see col.13, line 52-col.14, line 8).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7.1 Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ensel and further in view of Lakritz (US Publication 2003/0140316).

Regarding claim 32, please note that it has been rejected under first paragraph of 35 U.S.C. 112 as being not enabled. Ensel teaches particularized billing services as analyzed and

Art Unit: 3625

discussed in claim 1 above. Ensel does not disclose the steps of selecting a language in which to produce the bill and converting all correlated data to the selected language prior to generating the bill. However, Lakritz discloses this limitation of selecting a language in which to produce a document [document includes a bill] and convert all correlated data to the selected language prior to generating the document for the intended recipient (see at least the "Abstract ", Figs 2,3,5,7,10,.12, and paragraphs 0001, 0011-0014, 0028-0029, 0109 and 0125). In view of Lakritz, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Ensel to incorporate the feature of selecting a language in which to produce the document or a bill and converting all correlated data to the selected language prior to generating the bill because it would help the system for allowing a conversion to be made from a source language to the native language of the consumer and would provide a convenient way to produce and provide documents including bills in the target language of the recipient of the document, as explicitly demonstrated in Lakritz.

8 *Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.*

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:


US Publication 6,904,401 (Hauduc et al, see at least Abstract, Figs 1, 5-8, col.3, lines 14-36, col.5, line 66-col.6, line 11, col.7, line 46-col.7, line 17) and US Publication 2002/0111933 A1 (Noble et al, see at least Abstract, Figs 2A, 2B and 9, and paragraphs 0027-0029, 0034 and 0056) disclose the concept and benefits of selecting a language in which to produce a document including a bill and converting all correlated data to the selected language prior to generating the document including a bill.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
10/12/2006